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Richard Hendrickus Brinkhuis

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HOWREY LLP-HN

C/O IP DOCKETING DEPARTMENT

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FALLS CHURCH, VA 22042-7195

EXAMINER

NGUYEN, HAIDUNG D

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### ADVISORY ACTION

1. This action is responsive to applicant's amendment filed 3/17/2010.
2. Claims 1-24 are currently pending with claims 1-7, 12 are withdrawn from consideration as being drawn to a non-elected invention.
3. The request for reconsideration has been considered but does not place the application in condition for allowance because:

Applicant argues that Kurosaki et al (JP 2000-226442) fails to disclose a claimed limitation because Kurosaki does not teach or suggest a rheology modification agent at all. However, Kurosaki discloses the product obtained by react polyisocyanates (tolylene diisocyanate, diphenylmethane diisocyanate, phenylene diisocyanate, naphthalene diisocyanate - para 0006 In 4-7, para 0007, In 5) with monoamines (methylbenzylamine, para 0005, In 8). Since the product of Kurosaki is obtained by the same chemical reaction as set forth in claim 8 (see the abstract, para 0006 and 0007); it appears that this reaction product would have inherently exhibited rheology modification properties because all the material/chemical limitations of the instant invention have been satisfied. In light of this, it has been found that, products of identical chemical composition can not have mutually exclusive properties and a chemical composition and its properties are inseparable. See *In re Spada*, 911 F.2d 705,709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Applicant further argues that Kurosaki et al fails to disclose a claimed limitation because Kurosaki does not teach a mixture of optically active monoamines in enantiomeric excess with polyisocyanates. Applicant further argues that Kurosaki does

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not discuss the concept of chirality (optical activity) at all. However, Kurosaki discloses the product obtained by the chemical reaction between polyisocyanates (tolylene diisocyanate, diphenylmethane diisocyanate, phenylene diisocyanate, naphthalene diisocyanate - para 0006 In 4-7, para 0007, In 5) with monoamines. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention the burden of proof is shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103. See *In re Fitzgerald*, 619 F2d 67, 205 USPQ 594 (CCPA 1980). MPEP § § 2112- 2112.02.

With regard to the rejection over Buter in view of Kurosaki, applicant argues that the examiner has failed to show some suggestion or motivation to modify or combine the reference teachings. However, Buter discloses a rheology modification agent (sag control agent -abstract) obtained by reacting one or more polyisocyanates (col 1, In 36-57) with one or more methylamine such as .alpha.-methylbutylamine, and .gamma.-methylbutylamine (col 1, In 60-66). Buter does not disclose the monoamine being one or more optically active carbon-substituted methylamines of formula I, wherein the amine of formula I is not an optically active amino acid and not an optically active amino acid ester. In a similar invention, Kurosaki et al discloses a reaction product of one or more polyisocyanates (para 0006) with a methylamine (methylbenzyl amine - para0007) for improve temperature sensitive in adhesive compositions as described above.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed methylbenzyl amine taught by Kurosaki in the theology modification agent of Buter as an equivalent alternative methylamine, for improving the temperature sensitive in laminations and adhesives (para 0025). Even though Kurosaki does not discuss the concept of chirality (optical activity); however, when the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention the burden of proof is shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103. See *In re Fitzgerald*, 619 F2d 67, 205 USPQ 594 (CCPA 1980). MPEP § § 2112- 2112.02.

With regard to the rejection over Buter in view of Kurosaki and Flosbach, applicant argues that the examiner has failed to show some suggestion or motivation to modify or combine the reference teachings because Flosbach fails to disclose optically active amines. However, as stated above, the burden of proof is shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on in the rejection.

The rejection of claims 8-11, 13-24 are maintained for the reasons of records.

***Examiner Information***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haidung D. Nguyen whose telephone number is (571)270-5455. The examiner can normally be reached on M-Th: 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Harold Y Pyon/  
Supervisory Patent Examiner, Art  
Unit 1796

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Art Unit 1796

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